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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,834	10/07/2003	Douglas Hadfield	P385	5409

7590 07/06/2004

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EXAMINER


CLARKE, SARA SACHIE

ART UNIT PAPER NUMBER

3749

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,834	Applicant(s) HADFIELD, DOUGLAS 	
	Examiner Sara Clarke	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 5-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (the UK search report) filed October 7, 2003, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. See 37 CFR 1.85(a).

Specification

The abstract of the disclosure is objected to because the reference numbers are inconsistent with those in the specification and drawings. "29" should be "31" and "30" should be "29." Correction is required.

Claim Objections

Claims 5-14 are objected to because of the following informalities: In claim 5, line 1, "Claims" should be "Claim" (singular). In claim 7, the language "with the diameter

forms the fireback opening" is awkward. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation 15-25 degrees, and the claim also recites 21 degrees which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 8-10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (CH 665012).

Park discloses the invention as claimed including walls with inner surfaces that slope steadily inwardly to decrease the cross sectional area of the fireback, a larger area being at a height substantially the level of the fire bed and a smaller area being adjacent the throat. See element 5 (burning chamber) in Fig. 3. Park further discloses a vertical base portion of the fireback. See Fig. 3. The fire bed is the portion of the fireplace where the vertical base portion and the sloping portion meet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) in view of Zeller (CH 627832).

Park discloses the invention substantially as claimed with the exception of raised surface features in the form of corrugations or undulations, which form peaks lying in

planes substantially parallel to the base of the fireback.

Zeller discloses a fireplace and teaches the use of an insert including undulations (see Figs. 3 and 4) to improve heat absorption. See column 2, lines 40-44.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the fireplace of Park with undulations as taught by Zeller for the purpose of improving heat absorption.

Claims 6, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) in view of Buffington (US 2003/0019490).

Park discloses the invention substantially as claimed with the exception of a semi-circular cross-section and is frustoconical in shape.

Buffington discloses a fireplace and teaches the use of a semi-circular interior (see the abstract and Fig. 3) for the purpose of providing a kiva-style fireplace.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the fireplace of park with a semi-circular shape (and consequently a frustoconical 3D shape) as taught by Buffington for the purpose of changing the style of the fireplace to be more kiva-like.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) in view of Buffington (US 2003/0019490) as applied to claim 6 above, and further in view of Hendricks (US 3301249). Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) in view of Hendricks (US 3301249).

Park (claim 12) and Park and Buffington (claim 11) disclose the invention substantially as claimed with the exception of the fireback being formed as a single refractory cement casting.

Hendricks discloses a fireplace and teaches the use of making the fireback of a single refractory cement casting for the purpose of more quickly erecting the chimney structure. See column 1. See also column 4, lines 9-24.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to form the fireback of Park or Park and Buffington as a single refractory casting as taught by Hendricks for the purpose of erecting the chimney structure quickly.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Andrews (US 4013059) discloses a fireplace with sloping walls. Flynn, Jr. (US 2825326) discloses an arcuately shaped reflector panel.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Clarke whose telephone number is (703)308-1388. The examiner can normally be reached on Mon-Fri, 8:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached at (703)308-1935. The fax phone number for the organization where this application is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Clarke 
Primary Examiner
Art Unit 3749

June 25, 2004